

PATENTS
Attorney Docket No. SYN-017#13
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12-10-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Maarten H. Stuiver *et al.*

Serial No.: 09/581,331

Filing Date: July 21, 2000

Title: Constitutive Plant Promoter

Art Unit: 1635

Examiner: K. Lacourciere

Assistant Commissioner for Patents
Washington, DC 20231**RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121 AND § 372**

Applicants hereby respond to the Office Action dated September 7, 2001, which detailed a Restriction Requirement under 35 U.S.C. §§ 121 and 372. A Petition for a two-month Extension of Time for Response, up to and including December 7, 2001, is submitted herewith. The Action contained a two-way Restriction Requirement. The Examiner grouped the claims as follows (Office Action, page 2):

Group I, claims 1-8, drawn to a chimeric plant promoter, wherein the promoter is a combination of the ferredoxin and rolD promoters; and

Group II, claims 1-3 and 9-15, drawn to a chimeric plant promoter, wherein the promoter is a combination of the plastocyanin and the S-adenosyl-methionine-1 promoters.

Applicants respectfully traverse this Restriction. Applicants contend that the subject matter of Groups I and II, claims 1-15, is united by a single inventive concept under PCT Rule 13.1 with the same or corresponding special technical features required by PCT rule 13.2. The invention relates to a chimeric plant promoter that "comprises a minimal promoter and transcription-activating elements from a set of promoters, which

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elements have a complementary pattern and level of transcription in a plant," as recited in claim 1. The unifying inventive concept and corresponding special technical feature of Groups I and II is the use of promoters and transcription-activating elements with complementary expression patterns of transcription in plants.

The Examiner cites Gelvin *et al.* as disclosing the use of plant promoters with complementary expression patterns. Applicants respectfully disagree. Gelvin discloses a chimeric plant promoter comprising transcription-activating elements from the mannopine synthase (mas) and octopine synthase (ocs) promoters linked to a minimal promoter. (Gelvin *et al.*, p. 6, l. 16-27) However, Gelvin also teaches that the mas and ocs genes do not have complementary expression patterns. The mas gene is predominately expressed in roots (mean level of 12024 pmol/min/mg), with significantly less expression in the stem (1117 pmol/min/mg) and leaves (987 pmol/min/mg). (Gelvin *et al.*, Fig. 2, Construct 2) The ocs gene is also predominantly expressed in the roots (803 pmol/min/mg), with less expression in the stem (309 pmol/min/mg) and leaves (566 pmol/min/mg). (Gelvin *et al.*, Fig. 4, Construct 8) Additionally, Kononowicz *et al.* teach that the "expression of the ocs gene is the greatest in the leaves and root tips, lesser in the stem and the flowers, and very low in the root base." (Kononowicz *et al.*, *The Plant Cell* 4:17-27 (1992)) Thus, the mas and ocs promoters are not complementary because both predominantly direct expression in the roots.

Therefore, Applicants assert that the subject matter of Groups I and II, claims 1-15, relates to a single inventive concept with the same special technical feature, namely, a chimeric plant promoter comprising a minimal promoter and transcription-activating elements with complementary patterns and levels of transcription. Withdrawal of the Restriction Requirement with respect to claims 1-15 is, accordingly, respectfully requested and believed to be in order. Upon withdrawal of the Restriction Requirement with respect to Groups I and II, claims 1-15, Applicants respectfully elect to prosecute claims 1-15.

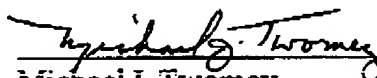
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Nevertheless, in the event that the Examiner disagrees with the traversal and does not withdraw the Restriction, and in order to be in full compliance with the Restriction, Applicants elect to pursue Group I, claims 1-8. Additionally, however, Applicants note that claim 15, as amended, is dependent upon claim 1 and should, therefore, be included in Group I.

Further and favorable consideration of all the claims of record on the merits is respectfully requested.

A Petition for a two-month Extension of Time for Response is submitted herewith, along with an authorization to charge the required fee to our Deposit Account No. 08-0219. No other fees are believed to be due. However, if any such fees are due, please charge them to our Deposit Account No. 08-0219.

Respectfully submitted,


Michael J. Twomey
Reg. No. 38,349

Dated: December 7, 2001

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Re: U.S. Patent Application No. 09/581,331 filed July 21, 2000
 Title: Constitutive Plant Promoter
 Inventor: Stulver et al.
 Examiner: K. Lacourciere - Group Art Unit: 1636
 Attorney Docket No.: 109846.129 (SYN-017)

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 Fee Transmittal Form
 Petition for 2 Month Extension of Time

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/581,331
	Filing Date	July 21, 2000
	First Named Inventor	Stuiver et al.
	Group Art Unit	1635
	Examiner Name	K. Lacourciere
Total Number of Pages in This Submission	6	Attorney Docket Number 109846.129 (SYN-017)

ENCLOSURES (check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Michael J. Twomey (Reg. No. 38,349)
Signature	
Date	December 7, 2001

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